

REMARKS

Claims 1-13 are all the claims pending in the application.

Claim Rejections - 35 U.S.C. § 103

Claims 1-8 and 11-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sagawa et al (e.g., 903,169) in view of Olmedo (6,174,170). This rejection is traversed for at least the following reasons.

As a preliminary matter, Applicants note that the Examiner has repeated the text of his previous rejection in the Office Action dated November 27, 2002. Thus, Applicants rely at least upon the arguments made in the previous Amendment filed on February 27, 2003 with regard to the Examiner's comments.

In the present Office Action, the Examiner notes that the arguments Applicants have filed were fully considered but are not persuasive. Specifically, in asserting patentability, Applicants previously argued that a significant feature of the invention comprises

- (1) the use of **commercially available music CDs** and the reproduction of music from such CDs,
- (2) the judgment of when certain of such CDs are used,
- (3) the provision of timing data for the player's operation of a controller, and
- (4) the execution of a game in coordination with a play of the **commercially available music CD**.

Applicants have demonstrated that the prior art does not meet these limitations. These features are clearly set forth in all of the rejected claims, but do not appear in the prior art.

In the Office Action, the Examiner admits that Sagawa lacks the ability to use a commercially available music CD (page 4 of the final Office Action). The Examiner states that Sagawa discloses “everything except for the ability to use a “**commercially available music CD.**” The Examiner asserts that (1) Olmedo remedies this deficiency and (2) Olmedo is combinable with Sagawa. Again, Applicants respectfully submit that the Examiner is mistaken with respect to each of the above-mentioned claim features.

(1) Use of a commercially available music CD

All of the claims require a game device, (claims 1 and 7) game distribution (claim 5), or information storage medium (claims 8, 10 and 12), all of which require a structure, code or ability to play a “**commercially available music CD**”. This is a key feature of the invention. Because of significant copyright concerns, an existing problem in the prior art is the potential violation of copyright where commercially available CD music is stored on the hard drive so that it can be matched with timing and programming. The present invention acts like a conventional standard CD player and simply reproduces commercially available music CDs as does a conventional handheld or desk-CD player, but with one or more additional significant features (2)-(4).

Sagawa does not use a **commercially available music CD**. This is admitted by the Examiner. Olmedo does not remedy this deficiency in the context of the claims when viewed as a whole. Olmedo requires a separate and accompanying source of timing information for each CD, whether in the form of imbedded special phase data, another timing CD or a memory cartridge.

As is clear from the columns 9, lines 32-37, and 61-62 in the Olmedo patent, the Olmedo records the phase advance data in the audio CD so as to display the text in accordance with the music. Therefore, the audio CD, which has been disclosed in the Olmedo, is not a **commercially available music CD** as used in the present invention. Olmedo uses a specialty CD that contains added timing or phase data.

By contrast, the present invention does not generate the timing data from the commercially available music CD. As disclosed in the specification of the present application at page 20, lines 14-18 and at page 23, lines 18 to 29, the present invention acquires the timing based on the current play position of the commercially available music CD and the timing data which is recorded in the game disk.

The special audio CD of the Olmedo patent does not record the timing data. However, the timing is provided in accordance with the phase advance data recorded in the audio CD when it is applied to the karaoke operation. When it is not applied to the karaoke operation, all the text would be simply displayed according to the operation of the music selection.

Nothing of the sort is required in the present invention, as timing is provided by a detection of the standard CD music. Moreover, there are other significant related features (2)-(4) that are not in the prior art, as subsequently explained.

(2) Use of a CD Judgment Structure or Step

The present invention requires a commercially available music CD judgment means or step to determine if a predetermined type of commercial music CD is being used, based on the music content. This is an important feature involving a determination as to whether the CD is of a predetermined type of commercially available music CD that can be read to detect play

position information for use in developing timing. This involves a programmable choice between a predetermined type and types that are different.

There is no such judgment in Sagawa. Since, there is no commercially available CD contemplated by Sagawa, such judgment cannot exist. Moreover, since Sagawa does not even contemplate use of a commercially available CD, no need for such judgment exists. Indeed, the focus in Sagawa on CD's with timing and music combined would lead one of ordinary skill away from use of such judgment means or step.

Olmedo does not teach such judgment either since Olmedo relies upon a separate source of timing for any CD that is played, specifically, a separate timing CD or other memory.

Nothing in either reference would lead one skilled in the art to implement such judgment means or step, as there is no reason to do so.

(3) Provision of Timing for Operation of a Controller

The present invention solves a need for synchronization between the output from the play of the conventional music CD and a game. The game must identify timing instances at which a player should operate a controller in accordance with the music that is produced from such a conventional CD. In this context, the "controller" is a device 32 as illustrated in Fig. 2 of the application that has buttons 34, 36 and 38 through which a player manually enters commands to the game processor 14. It is clear that the timing for operating a controller is directed to a player. The term "controller" is not used to refer to the processor itself. There are various dedicated controllers for music games such as a dance mat type, a guitar type, and a drum type, in addition to the type disclosed in Fig. 2 of the specification of the present application. The player operates the controller in accordance with instructions and images displayed on the screen, as explained

beginning at page 16 of the specification. The instructions and timing are derived from reading the music on the conventional music CD.

Sagawa cannot have such feature since it does not use a conventional music CD, as admitted by the Examiner. Olmedo cannot have such device since it is not a game machine and has no “controller”. Thus, neither reference teaches the claimed structure or step. The Examiner’s reference to “the controller senses/judges and identifies text characters” (page 3 of the Office Action) references an inapplicable structure namely a processor. The Applicant does not use the term “controller” in that sense but uses it in a conventional sense in the video game arts. Moreover, the claims refer to the player operating a controller, a reference clearly not at all applicable to a processor. Specifically, the claims require use of operation timing data which indicates the timing at which a player should operate a controller in accordance with the game music reproduced from the commercially available music CD. The Examiner must use the term as defined by the Applicants and as used in the specification and claims, and as is conventionally understood in the art.

Given the definition, the prior art is deficient in such teaching. Thus, there cannot be a storage means or step of storing timing data indicative of timings at which the player should operate a controller. There is not provision in any of the prior art of a memory having timing based on a recorded content of a conventionally available music CD for a player operation of a controller.

(4) Execution of a Game with a Controller According to Provided Timing

Finally, the claims require a structure or step of executing a game to reproduce the music on a **commercially available music CD** in response to the judgement function (of which there is

none in the prior art) and for guiding timings in which the player should operate a controller based on the operating timing data. Again, there is no such use of a “controller” in the prior art. The Examiner asserts that Olmedo’s system provides text of song on a display that indicates a timing. The Examiner asserts that this is equivalent to operation timing data indicative of times at which a player should operate a controller in accordance with game music. However, there is no controller in Olmedo’s system. A karaoke machine is not combined with a controller for use by a player.

In sum, viewing the claimed invention as a whole, none of the additional points (2) - (4), which together define the present invention, are found in Sagawa or Olmedo. There is no judgement means or step, no requirement for operation of a controller in accordance with the game music reproduced from a **commercially available music CD** and no execution means or step which guides timing at which a player should operate a controller based on the operating timing data that has been generated. These are structural and functional limitations in the claims that are important to the claimed game environment but clearly cannot be found in Sagawa et al, since it does not reproduce commercially available music CDs. They cannot be found in Olmedo since it is not a game machine.

Given the absence of key features from each of the two references, one skilled in the art would not be motivated to derive the present invention from their teachings and, in fact, would be led away from the present invention.

Sagawa Teaches Away From Use of a Commercially Available Music CD

Viewing Sagawa as a whole, and not “piecemeal” as the Examiner argues, an entirely different approach to providing music in combination with a game is presented. The electronic

circuitry, software and algorithms associated with the Sagawa et al system teaches towards specialized programming and storage media, rather than the use of **commercially available music CDs**. There is no motivation in Sagawa et al or even a recognition that it would be desirable for use of a **commercially available music CD**.

Olmedo Teaches Away From the Present Invention

The Examiner states that he relies on Olmedo to teach the feature of using a **commercially available music CD** to play a game. However, the Examiner's reliance on Olmedo is misplaced.

First, Olmedo does not teach a game. Olmedo teaches a karaoke machine, which is not a game machine but a sing-along entertainment device. In a karaoke machine, there must be either (1) a storage medium that combines music with instructions for singing (words, tempo and video) or (2) separate but coordinated sources of music and instructions. A commercially available music CD alone cannot be used. As already noted, the CD used by Olmedo and relied upon by the Examiner uses phrase advance data in combination with music. This is not a **commercially available music CD**. By contrast, the present invention uses a commercially available music CD and does not rely on special data or phase information to provide timing.

Second, music reproduction, instructions or programming that may be provided by Olmedo relate to instructing a participant to sing, rather than use a controller. There is no reason to use a controller in Olmedo, as it is not a game machine. Thus, Olmedo teaches away from the combination as claimed, which expressly relies on the use of a **commercially available music CD** and a game controller.

Third, Olmedo teaches that a separate storage medium, on which text characters are stored, which may be a storage cartridge or a specialized timing CD, must be used. This teaches away from the feature of the present invention that relies on the music from a commercially available CD to generate the timing data for operation of a controller by a player.

The Examiner is Using Hindsight and Still Cannot Create the Invention

Applicant respectfully submits that the Examiner must use impermissible hindsight in any attempt to merge a game system as in Sagawa, which relies upon the combined storage of timing and music on a single CD, with a karaoke machine that has no relationship to a game and no need for a controller. Moreover, as already pointed out, the karaoke machine in Olmedo uses a CD that is not a commercially available disk, since it uses phrase advance data. Clearly, there still is an important missing element of the claimed invention. Thus, any assertion that the game in Sagawa may be combined with the karaoke machine in Olmedo, and further that such combination would be modified to remove timing required by Sagawa and special phase required by Olmedo, would involve a clear application of hindsight.

The limitations in the claim that define the entire invention cannot be met by the piecemeal combination of references based on hindsight as proposed by the Examiner. Nothing in Sagawa et al teaches or suggests the use of a conventional **commercially available CD**. Everything in Sagawa teaches the opposite. Nothing in Olmedo teaches the use of a game machine and a controller that is compatible with a **commercially available CD**. Olmedo requires the use of a special CD with phrase advance data in a first embodiment, and a need for a separate and compatible CD or storage device that contains timing in the second embodiment. Moreover, nothing in the second embodiment teaches or suggests use in a game environment,

Appln. No.: 09/783,328
Amendment Under 37 C.F.R § 1.116

particularly one with a controller. The only thing that Olmedo teaches is a conventional karaoke machine.

Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sagawa et al. (e.g., 903,169) in view of Olmedo (6,174,170) and further in view of Ng. This rejection is traversed for at least the following reasons.

With regard to the foregoing rejection of claims 9 - 10 under 35 U.S.C. § 103(a), the Examiner simply asserts that the Applicants' arguments amount to a "general allegation" that the claims define the patentable invention without specifically pointing out how the language of the claims patently distinguishes them from the reference. Applicant respectfully submits that the Examiner is mistaken in this regard.

Applicant argued here and in the previous Amendment that neither Sagawa et al nor Olmedo teach the game machine, process or method or medium as claimed that allows a **commercially available music CD** to be played without raising copyright problems. Nothing in this art teaches or suggests an environment in which a game controller may be used in coordination with timing derived from the music on a **commercially available CD**. The Examiner has not pointed to the structure in any of these prior art references that perform these functions for the four key points identified above. On this basis alone, the present rejection is overcome.

The Applicants further respectfully submit that Ng does not remedy these deficiencies. This is not a general allegation. It is specific in that the Examiner has admitted that Ng is cited solely for teaching downloading of a song, lyrics and images from a variety of sources, including the Internet. The Examiner cannot dispute that the fundamental deficiencies of the other

Appln. No.: 09/783,328
Amendment Under 37 C.F.R § 1.116

references have not been remedied by Ng. There is no teaching or suggestion as to how they may be remedied. Thus, Applicants response is more than a general allegation, but it is specific to the rejection raised by the Examiner. Accordingly, these claims should be considered patentable over the prior art.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

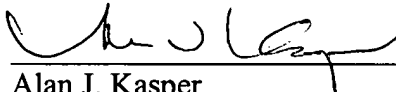
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Alan J. Kasper
Registration No. 25,426

Date: August 5, 2003